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Serial No.: 10/047,827
Atty. Docket No.: D5110

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thompson, Jason R.
Serial No.; **10/047,827** Group Art Unit: **3618**
Filed: **29 September 2001** Examiner: **Rosenberg**

For: **UNIVERSAL ACCESSORY-MOUNTING ASSEMBLY**

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The Examiner has raised arguments against several points in the applicants' appeal brief. The points are responded to here, basically in the order presented. Claims 1-40 were rejected in the original application, based on each of two combinations of references: (1) Applicant's Admitted Prior Art (AAPA) in view of Rawlinson '093 patent, or (2) the Murgas '883 patent in view of Rawlinson. It has been and remains the chief contention of the applicants that no valid basis for modification of either the AAPA or the Murgas '883 patent by the Rawlinson '093 patent based on teachings found in the prior art has been advanced. Because the Rawlinson reference has been applied independently to modify Murgas and AAPA the Rawlinson reference has been dealt with first.

The Applicants and the Examiner are in apparent disagreement as to the "universality" character of the "Rear View Mirror Mounting Arrangement for Boats" taught by the Rawlinson '093 patent. The Applicants argue that the device, in none of its embodiments, is a "universal accessory-mounting assembly" as recited and contemplated in the preamble to claim 1 or as an element in claim 18. The universality of the present invention lies in its attribute of being able to support diverse types of accessories. The

Examiner responds that the Rawlinson device is a "universal accessory-*mounted* assembly" (emphasis added) and further responds that the Rawlinson device is "universal" in that it is "versatile and could be adapted to meet various requirements" in that its construction allows it "to adapt to all windshields on the market". However, the application under appeal should be the source for determining what object is modified by the term "universal". Paragraph [0004] of the specification provides,

> an object of the present invention is to provide [a] universal accessory-mounting assembly that is cost effective and simple in construction with respect to prior art universal accessory-mounting assemblies and that can be mounted to any of a number of different construction of base structures which have outer surfaces with a number of different shapes.

In other words, prior art universal accessory-mounting assemblies existed which applicants viewed as being mountable on a relatively limited variety of surfaces. The natural inference is that these devices were universal in the sense that diverse accessories could be mounted on them. The Examiner, perhaps aware of the weakness of her position regarding the proper understanding of the term "universal" in the context of the present application adds that "though not specifically pointed out, the [Rawlinson prior art] assembly *could* be used for various accessory mountings". (again emphasis added). This is conjecture. However, it may be noted that in the Rawlinson device the mirror is positioned between two legs and is a necessary, functional component of the assembly and not something installed on an assembly. There is no "assembly" without the mirror.

The Examiner contends that the Applicants have argued that "Rawlinson does not teach biaxial movement of ball-and-socket joint". Applicants believe this statement mischaracterizes the appeal brief. Page 6 of the Appeal brief relates to the ball-and-socket joints disclosed in the Rawlinson '093 patent and describes in detail that the Rawlinson device, once assembled in position, provides mechanisms for limiting freedom of rotation of the ball-and-socket joints to one axis. In one of Rawlinson's embodiments a screw is introduced to the structure, and in the two other embodiments a "cylindrical ball socket"

slides into position to restrict freedom of movement of the ball-and-socket joints. Only then is movement of the joints no longer biaxial. The point of applicants' arguments on this point are meant to emphasize that Rawlinson did not contemplate, and did not provide, a teaching that would suggest use of ball-and-socket joints for a stable support assembly having three non-colinear points of support. The Rawlinson device used the joints so that his assembly could be folded down when not in use. For this to happen the joints must be aligned, which is of course always the case where only two are used and the axes of rotation aligned. The assembly of the application under appeal always has at least three points of support.

At page 4 of the Examiner's Answer it is stated that Applicants "argue" that the Murgas reference (for a Detachable Fender Mounted Rear View Mirror) differs from the invention of the application under appeal, the admitted prior art and Rawlinson in that it "is intended to be readily removable". That this is true is not contradicted by the Examiner. Applicants disagree with the Examiner's further argument that they have made no argument as to why this difference bears on patentability. Applicants argument on this point was folded into the argument as to why substitution of the ball-and-socket fittings of Rawlinson for fixed position hooks used in Murgas might defeat the function of Murgas. Referring to page 11 of the Appeal Brief applicants pointed out that "[W]hile Murgas intended his device to be readily detachable it is unlikely that Murgas intended his device to be self-detaching." Murgas himself stated that his device with its tripodal frame, hook feet and Y-shaped clamping rubber was intended to "hold[s] the feet in a clamped position and mount[s] the frame firmly in place with minimal vibration." (Col. 1, lines 43-52). Murgas further states "The unit can be taken from its carton installed on the fender or removed from the car and packed in its carton in less than 20 seconds. . . . no nuts, bolts, screws, or turn buckles are used . . .." (Murgas '883 patent, col. 1, lines 53-58). Applicants conjecture that Murgas did not intend the use of tools to remove or install the device. It has been applicants' position that such ease in removability of the device, achieved without

compromise of stability or security of the device when installed on the fender of a vehicle, is better served by fixed position feet. The applicants have considered the Examiner's counter-argument stated as follows:

> The Examiner contends that since Murgas's feet (#34,36) are fixedly engaged on the base structure (#39; best seen in figure 3) [Sic, reference numeral 39 in fact identifies the vehicle hood and not the base structure, (See col. 2, lines 36-38)], the addition of ball-and-socket joints in between the feet and the support legs (#16, 20, 28) would not cause the assembly to be inoperable because the feet would still be able to fixedly engage the base structure, as in the current Murgas reference, and they would not self-detach."

In response, the Examiner's argument is far from a teaching that would support making the proposed modification of Murgas in view of Rawlinson. Second, it is clear in Murgas that tension is applied to the feet by the Y-shaped clamping rubber 40 that is not directly aligned with the support legs 16, 20, 28. If the feet were rotatable, the clamping rubber, being under tension, would urge some rotational movement of the feet to relieve that tension. This would not improve security of the Rear View Mirror on the fender and certainly would not serve to minimize vibration. The Examiner, as the proponent of the modification, and charged with constructing a prima facie case of obviousness, would seem to carry the burden of proof that the modification would work, is suggested by the art, and would have been seen as desirable to the present inventors in conceiving their invention.

Finally, Applicant has argued that modification of either Murgas, or the admitted prior art, by Rawlinson is unsupported by any teaching in the references. The Examiner contends that this teaching is provided by Rawlinson because "Rawlinson teaches the use of ball-and-socket joints for multi-axial movement on surfaces of different shapes and sizes, which can be beneficial to assemblies with various numbers of legs." It is applicants' contention that Rawlinson teaches the use of two legs fitted with ball-and-socket joints to allow the mirror assembly to be fitted to a multi-angled windshield. After being so fitted,

freedom of movement of the joints is limited, to provide an assembly which can be folded downwardly. Downward folding is possible only if the axes of rotation of each joint are co-axial. Where the support legs are arranged to intercept support surfaces at the vertices of a triangle there can be no coincidence in the axes of rotation. Therefore Rawlinson provides no reason to incorporate ball-and-socket joints in a structure such as shown in the admitted prior art or Murgas. The ball-and-socket joint was not necessary in Rawlinson to achieve mating with a multi-angled windshield (See Fig. 3 of Rawlinson), but allowed such mating while preserving the ability to fold the structure downwardly.

Applicants submit that they have shown that the Examiner has failed to make a prima facie case of obviousness and the rejections should therefore be overturned.

Respectfully submitted,

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I hereby certify that this REPLY BRIEF is being deposited with the United States Postal Service, in triplicate, as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on or before 9/17/04.

9/17/04
Date

Cathi Majewski